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UNDER 37 CFR 1.10 - SEPARATE PAPER**

Applicant(s): Ross, et al.

Examiner: Toan C. To

Serial No.: 10/051,968

Group Art Unit: 3616

Filed: January 16, 2002

Date: May 23, 2006

**For: SPACER APPARATUS FOR SUSPENSION BEAM BUSHING ASSEMBLIES**

**"EXPRESS MAIL" LABEL NO.: EV529769371US**

**DATE OF DEPOSIT: May 23, 2006**

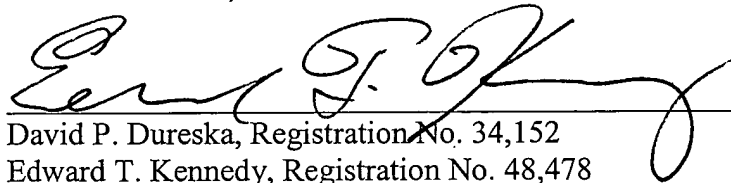
Sir:

The undersigned hereby certifies that the attached **PETITION UNDER 37 C.F.R. §1.181** was mailed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, via the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on May 23, 2006, before 5:00 p.m., thereby ensuring that such documents will be in the hands of the U.S. Postal Service by the close of business this day. Thus, timely filing has been made to the outstanding Office Action prior to expiration of the shortened statutory period for the same ending May 23, 2006.

It is believed that no fee is due; however, should a fee be required, the Director is hereby authorized to charge any additional fees which might be required to Account No. 50-0983.

Respectfully submitted,

BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. §1.181**

Sir:

Applicants file this Petition to invoke the supervisory authority of the Director pursuant to 37 C.F.R. §1.181, regarding the prematurity of a final rejection. The following sections are included in this Petition:

**Statement of Facts** begins on page 2 of this Petition.

**Point to be Reviewed** begins on page 3 of this Petition.

**Action Requested** begins on page 4 of this Petition.

**Memorandum in Support** begins on page 5 of this Petition.

### **Statement of Facts**

The instant application was filed on January 16, 2002. A non-final Office Action was mailed on November 10, 2003, and in that Office Action, the Examiner rejected Claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Japan Publication No. 11210794 (“the ‘794 Publication”), and rejected Claim 4 under 35 U.S.C. §103(a) as obvious over the ‘794 Publication in view of prior art FIG. 1 of the instant application. Applicants fully responded to the non-final Office Action in their Response A mailed on April 15, 2004.

A final Office Action was mailed on July 27, 2004. In that Office Action, Claim 1 was rejected under 35 U.S.C. §102(b) as anticipated by the ‘794 Publication, and Claim 4 was rejected under 35 U.S.C. §103(a) as obvious over the ‘794 Publication in view of prior art FIG. 1 of the instant application. Applicants responded to the final Office Action in their Response B mailed on January 25, 2005. An advisory action was mailed on February 14, 2005.

Applicants then filed a Request for Continued Examination on February 23, 2005. A non-final Office Action was mailed on June 28, 2005, in which Claims 1 and 4 were rejected under 35 U.S.C. §103(a) as obvious over the ‘794 Publication in view of prior art FIG. 1 of the instant application. Applicants responded to the Office Action in their Response C, mailed on December 16, 2005. Then, on March 23, 2006, a final Office Action was mailed. However, in the March 23, 2006 Office Action, Claims 1 and 4 were rejected for the first time under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,809,960 (“the ‘960 Patent”) in view of prior art FIG. 1 of the instant application.

**Point to be Reviewed**

Applicants respectfully submit that the March 23, 2006 Office Action was prematurely designated as final, since the Examiner relied on the '960 Patent for the first time in making a rejection based on that reference.

**Action Requested**

Applicants respectfully request that the Director withdraw the finality of the rejection set forth in the March 23, 2006 Office Action.

**Memorandum in Support**

Applicants initially note that they are aware that it is desirable to raise the prematurity of the rejection with the Examiner. Applicants shall do so in a Response to the March 23, 2006 Office Action, which will be filed shortly. In addition, Applicants have provided a courtesy copy of this Petition to the Examiner. Applicants have filed this Petition before the mailing of their Response to the March 23, 2006 Office Action to comply with the two-month time for the filing of a Petition set forth in 37 C.F.R. §1.181(f).

Turning now to the basis for this Petition, the Examiner had relied on the '794 Publication for prior rejections, and switched to the '960 Patent for the final rejection in the Office Action mailed on March 23, 2006, relying on the '960 Patent for the first time. Applicants respectfully submit that the finality of the rejection based on the '960 Patent is premature, and therefore the finality of the Office Action should be withdrawn.

Applicants believe that the finality of the rejection is premature for the following reasons. First, as noted in MPEP §706.07(a), actions on the merits shall be made final "except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" (emphasis added). Applicants argue that the Examiner's introduction of the '960 Patent, which previously was not utilized as a ground of rejection in the lengthy prosecution of the instant application, was not necessitated by Applicants' submission of an IDS or amendment of the claims. First, Applicants did not submit a new IDS between the time of the prior Office Action mailed on June 28, 2005 and the instant Office Action mailed on March 23, 2006. Second, as to Applicants' latest amendment of the claims in their Response "C" mailed on December 16, 2005, and in particular, to the amendment made to independent Claim 1, the

amendment merely was filed to *clarify* the claims. More specifically, Claim 1 was amended to more particularly point out, in the preamble, that the axle/suspension system is a heavy-duty vehicle axle suspension system. Thus, Applicants respectfully submit that such a clarifying amendment did not trigger the new ground of rejection. Therefore, on this basis alone, Applicants request the Director to withdraw the finality of the rejection as permitted under MPEP §706.07(d).

For the following additional reasons, either standing alone or in combination with each other and/or the reasons set forth above, Applicants believe that the Director should withdraw the finality of the rejection.

First, MPEP §706.07 sets forth the issues an Examiner should consider before making a rejection final: “Before final rejection is in order, a clear issue should be developed between the examiner and applicant” (emphasis added). This was not done in the instant prosecution. The fact that the Examiner raised a new ground of rejection based on the ‘960 Patent for the first time in the March 23, 2006 Office Action shows that a clear issue has not been developed.

Further, Applicants filed the instant application on January 16, 2002. The latest Office Action mailed on March 23, 2006 stands as the fourth Office Action in this case. Nonetheless, the prosecution of this application has passed the four-year mark. As noted in MPEP §706.07, “To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied...” (emphasis added). However, the Examiner has only now, in the fourth Office Action, applied and relied on the ‘960 Patent as a reference for a rejection for the first time. Obviously, the ‘960 Patent was not “fully applied” as

required by MPEP §706.07. Again, for this reason alone, the finality of the rejection should be withdrawn.

In addition, MPEP §706.07 goes on to state “Switching...from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will likely tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, *i.e.*, either an allowance of the application or a final rejection.” The Examiner clearly has violated this “switching” principle. In all prior Office Actions, the Examiner has relied on the ‘794 Publication, and Applicants made arguments respecting the ‘794 Publication in each of their respective responses: Response “A” (mailed on April 15, 2004); Response “B” (mailed on January 25, 2005); and Response “C” (mailed December 16, 2005). Then, in the fourth Office Action, the Examiner now has “switched” to the ‘960 Patent, despite the fact that the subject matter of the claims has remained substantially the same throughout this prosecution. In so doing, the Examiner has extended the prosecution rather than directing it to early termination.

As further noted in MPEP §706.07, “present practice does not sanction hasty and ill-considered final rejections,” but that “the applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his or her application” (emphasis added). Applicants strongly believe that they have been prematurely cut off in the prosecution of this application by having a new ground of rejection, *i.e.*, the ‘960 Patent, raised for the first time and applied without basis for a rejection under 35 U.S.C. §103(a), particularly when Applicants merely amended the preamble of Claim 1 to clarify the subject matter. Applicants believe that this action on the part of the Office clearly



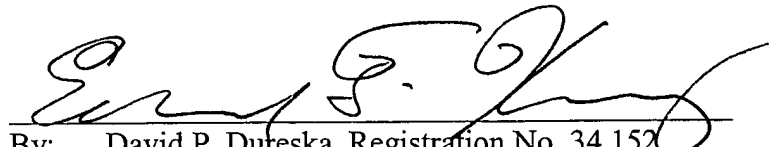
is not in keeping with the spirit, if not the letter, of the "cooperation" and aversion to premature "cut off" addressed in MPEP §706.07.

MPEP §706.07 also warns that examiners "should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Again, raising a new ground of rejection using the '960 Patent clearly ignores this warning, as well as the MPEP admonition that grounds of rejection be "clearly developed to such an extent that applicant may readily judge the advisability of an appeal." MPEP §706.07.

In summary, Applicants respectfully request the Director to withdraw the finality of the rejection in the March 23, 2006 Office Action and allow the claims as they stand, including Claims 1 and 4 and previously allowed Claims 2, 3 and 11-13.

Respectfully submitted,

BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP

A handwritten signature in black ink, appearing to read "David P. Dureska", is written over a horizontal line.

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